

REMARKS

Claims 1-28 are currently pending. Claims 1-11 and 23-28 have been withdrawn from consideration pursuant to a restriction requirement, which Applicants have traversed.

Claims 19-22 have been allowed. Claims 12-18 were rejected under 35 U.S.C. § 103(a) over U.S. Pat. No. 4,414,260 ("Rzepecki") in view of U.S. Pat. No. 5,591,382 ("Nahass"). Applicants respectfully traverse.

To establish a *prima facie* case of obviousness, the prior art must suggest the desirability of the claimed invention. MPEP § 2143.01. In other words, there must be some teaching or suggestion in the cited references (and not by hindsight gleaned from Applicants' specification) to motivate one of ordinary skill in the art to combine Rzepecki with Nahass, and to specifically to modify Rzepecki with Nahass to obtain Applicants' claims invention. MPEP § 2143.01. Applicants respectfully submit that there is no such motivation and thus, Applicants' claims are nonobvious over the cited references.

Rzepecki is directed to a multi-layer conductive web for use as an upholstery material and the like (*i.e.*, meaning materials which are like upholstery, not materials like housings, trays or packaging materials). Abstract, col. 1, lines 11-13, lines 39-41. This is further confirmed by the prior art open-weave fabric web which Rzepecki seeks to improve upon (col. 1, lines 23-36) as well as the goal of Rzepecki to provide a web or upholstery (col. 1, lines 47-51). Rzepecki's claims are further limited to upholstery fabrics or upholstery material and the like (*i.e.*, materials which are like upholstery and not like housings, trays or packaging materials). Claims 1-8.

On the other hand, Nahass is directed to high strength conductive polymers with superior toughness. *E.g.*, Abstract; col. 1, lines 7-9; col. 2, lines 40-44. As noted by the Examiner, useful applications for Nahass' invention include the formation of, *inter alia*,

housings, trays, and packaging materials. Office Action, p. 4. There is no mention or suggestion anywhere in Nahass for using his invention to form upholstery, fabric or the like. As such, Rzepecki and Nahass are in completely different fields and applications. Without the benefit of impermissible hindsight from Applicants' specification, one of ordinary skill in the art would not be motivated to combine Rzepecki with Nahass. More specifically, one of ordinary skill in the art would not be motivated to modify the upholstery fabric of Rzepecki by using the teachings of a references which is directed to materials such as, *inter alia*, housings, trays or packaging materials.

As such, Applicants' claims are patentable over Rzepecki and Nahass and withdrawal of this rejection is respectfully requested.

In conclusion, Applicants submit that the remaining claims 12-18 are in condition for allowance and a notice to that effect is respectfully requested.

If there are any additional fees, please charge them to our firm Deposit Account No. 50-0540.

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Respectfully submitted,

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